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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/840,497 | 04/23/2001 | Samuel T. Barone JR. | 42244/JEC/M770 | 4459 |
| 23363 | 7590 | 02/03/2006 | EXAMINER | |
| CHRISTIE, PARKER & HALE, LLP | | | YIMAM, HARUN M | |
| PO BOX 7068 | | | ART UNIT | |
| PASADENA, CA 91109-7068 | | | PAPER NUMBER | |

2611

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/840,497

Applicant(s)

BARONE ET AL.

Examiner

Harun M. Yimam

Art Unit

2611

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


CHRISTOPHER GRANT
SUPERVISORY PATENT EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because:

1. In response to applicant's argument (page 1, 2nd paragraph) that there is no suggestion to combine Bertram and Feinleib, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the cited benefit of utilizing enhancing content to enhance a particular television program as expressly recited in Feinleib, see column 5, lines 25-56
2. In response to applicant's argument (page 3, 2nd paragraph) that the combination of Bertram and Bauchot would render Bertram's system unsatisfactory, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). As previously said in the Final Office Action, Bauchot was simply introduced to teach manipulating data units assigned to particular time slots in data streams (see figure 5 and column 5, lines 32-37). Manipulating data units include the steps of identifying time slots assigned to the plurality of first data units in the first data stream; reassigning a portion of the plurality of first data units assigned to particular time slots to earlier time slots; and assigning at least a portion of the plurality of second data units in the second data stream to the particular time slots. Furthermore, Bauchot's teaching of reassigning a portion of the plurality of first data units assigned to particular time slots to earlier time slots is not limited to a program stream: one program. Feinleib was introduced to teach that the first and second data streams are for the same particular television program. The plurality of data units reassigned to earlier time slots in Bauchot could be independent program packets, in which case the relative position of each packet associated with a particular program remains the same with respect to the other packets within the program, as taught by Bertram—paragraph 0025, lines 5-7, and therefore the combination is proper.
3. Applicant argues (page 4, 4th – 6th paragraph) that first, nothing in Feinleib teaches or suggests an "ITV data stream" that includes "ITV reveal command data and ITV payload data", second, nothing in Feinleib teaches or suggests that the script also includes time slots that could be investigated for availability, and third, Feinleib makes no mention of whether, or how, the insertion of the ITV related data into the closed captioning script modifies the timing of the closed captioning payload data, and proposes no solution to handle any such modification.

In response to applicant's first argument (page 4, 4th paragraph) that nothing in Feinleib teaches or suggests an "ITV data stream" that includes "ITV reveal command data and ITV payload data", the Examiner cites column 8, lines 38-40 where Feinleib explicitly discloses ITV reveal command data (supplemental data i.e., URL, trigger, or application name) and ITV payload data (web page, graphical data—column 5, lines 45-65).

In response to applicant's second argument (page 4, 5th paragraph) that nothing in Feinleib teaches or suggests that the script also includes time slots that could be investigated for availability, and that could be assigned to closed caption data and ITV reveal command data, the Examiner cites column 7, lines 41-50 where Feinleib discloses determining an appropriate place in the closed captioning script to insert the enhancing content.

In response to applicant's third argument (page 4, 6th paragraph) that Feinleib makes no mention of whether, or how, the insertion of the ITV related data into the closed captioning script modifies the timing of the closed captioning payload data, and proposes no solution to handle any such modification, the Examiner would like to first point out that what is being argued is not claimed and cites column 7, lines 48-53 where Feinleib discloses that the author uses the authoring computer (50 in figure 2) to insert supplemental data in the form of a URL at the appropriate place in the closed captioning script.